IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/598,777   Confirmation No.:   1177

Applicant : Anja FECHER, *et al.*

Filed : September 11, 2006

Title : TETRAHYDROPYRIDOINDOLE DERIVATIVES

TC/Art Unit : 1625

Examiner: : Rita J. DESAI

Docket No. : 66535.000013

Customer No. : **21967**

MAIL STOP Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Response to Petition Decision Dated July 22, 2010

Patent Owner respectfully requests reconsideration of the Petition Decision dated July 22, 2010 ("Petition Decision"). The Petition Decision incorrectly attributed the 75 days between the filing of the response to the Election/Restriction (September 28, 2009) and the filing of the Supplemental Amendment (December 12, 2009) as Applicant Delay because it incorrectly found that the Supplement Amendment was not "expressly requested" by the Examiner.[1] As discussed below, Examiner Desai did expressly request the claim amendments reflected in the Supplemental Amendment. Therefore, the correct patent term adjustment (PTA) for this patent of 833 days is reflected on the face of the patent and no certificate of correction is necessary.[2]

Initially, the Petition Decision *failed to acknowledge* the Interview Summary dated December 4, 2009, and the Notice of Allowability at pages 2–3. Applicant's undersigned counsel notes that the Supplemental Amendment filed December 12, 2009 was expressly requested by Examiner Desai in a telephonic interview dated December 4, 2009. Specifically, Examiner Desai proposed numerous changes to the claims that, if made, would put the application in condition

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[1] Under 37 C.F.R. § 1.704(c)(8), a Supplemental Amendment that is "expressly requested by the examiner" is not counted toward Applicant Delay.

[2] Patent Owner no longer contests the 2 days of Applicant Delay related to filing the response to Election/Restriction on September 28, 2009.

for allowance. The December 4, 2009 Interview Summary demonstrates that the Examiner made specific proposals for claim amendments:

SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:

The examiner and the attorney discussed potential rejections. the examiner explained the 112 2nd para for C0-C5 alkylcarbonyl. C0- carbonyl would be C=O only and chemically not possible.

The provisoes because of art make the C1-C5 alkoxycarbonyl groups also obvious, recommended deletting it.

Claims 13 had the term medicament comprising without any other ingredient. the examiner suggested changing it to pharmaceutical composition with the carrier as given in claim 14.

Delete claim 18 and amend claim 15 to read the antogonizing as given on page 69. (delete preventing and treating)

In response to the Examiner's numerous proposals, Applicant filed the Supplemental Amendment which the Petition Decision erroneously concluded was the basis for reducing the PTA.

The Supplemental Amendment filed December 12, 2009 canceled the independent claim 1 and presented new claim 19, which addressed the Examiner's concerns by amending the R5 group of Formula (I) to recite "phenyl-carbonyl or naphthyl-carbonyl, optionally substituted . . ." thereby deleting from the claims the C_0-C_5 alkylcarbonyl and C_1-C_5 alkoxycarbonyl groups mentioned in the Interview Summary. Claim 13 was cancelled from the claim. Claim 18 was amended to remove the term "preventing and treating." In addition to these changes, Applicant further amended the claims to correct minor grammatical issues and delete specific compounds no longer included in the general formula of the new independent claim. Although the Supplemental Amendment included changes not specifically requested by the Examiner, the Supplemental Amendment addressed the Examiner's concerns as outlined in the October 16, 2009 Notice of Allowance. The Notice of Allowance acknowledged the supplemental amendment, specifically noting the amendment of the R5 group, and stated that "[t]he applicants amended the claims limiting them to specific substituents and now the claims 4, 6, 10, 14, 15, 18, 19-36 are found to be allowable." Notice of Allowance at 3.

Finally, Patent Owner would have insisted that the Examiner issue a formal office action at the time of the Interview if it were clear that filing a Supplemental Amendment would result in a reduction of PTA. If the Petition Decision stands it will stifle the ability of examiners and applicants to reach agreement on the claims after the applicant has filed a response. The policy reflected in the Petition Decision will therefore effectively increase pendency generally rather than reduce pendency. As the Supplemental Amendment filed in this case actually reduced pendency by avoiding another formal office action, it would be improper to penalize Patent Owner by reducing the allotted PTA.

For the foregoing reasons, the Petition Decision improperly attributed the 75 day delay between the response to the Election/Restriction and the Supplemental Amendment to Applicant. The correct Patent Term Adjustment includes 835 days of Patent Office delay minus the 2 days attributable to the September 28, 2009 filing in the response to Election/Restriction. The correct patent term adjustment of 833 days is thus correctly reflected on the face of the patent and no certificate of correction is necessary. Patent Owner respectfully requests reconsideration of the Petition Decision and acknowledgement that the '132 Patent reflects on its front page the correct patent term adjustment of 883 days. The Commissioner is hereby authorized to charge payment of any fees required under 37 C.F.R. § 1.16 and 1.17 associated with this communication or credit any overpayment to the deposit account of Hunton & Williams, Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Date: August 23, 2010

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